REMARKS/ARGUMENTS

The Office Action mailed October 28, 2005 has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

With this response it is respectfully submitted the claims satisfy the statutory requirements.

The 35 U.S.C. § 101

Claims 74-97 were rejected under 35 U.S.C. § 101, allegedly because the claimed invention is directed to non-statutory subject matter. This objection is respectfully traversed.

The Office Action states:

> The language of claims 97 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101...
>
> While claim 74 recites "a method for predictively responding to a network management request", there is nothing in claims 74-81 that explicitly indicate that a computer is performing any of the steps...
>
> While claims 82 and 90 recite "an apparatus for predictively responding to a network management request", there is nothing in claims 82-89 or 91-97 that explicitly indicate that a computer is performing any of the steps.

M.P.E.P. 2106 (IV) (*B*) states that "[t]o properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. 101, Office personnel should

classify each claim into one or more statutory or nonstatutory categories." The nonstatutory categories are provided in that section of the M.P.E.P. as being one of the following:

(a) Functional Descriptive Material: Data Structures representing descriptive material per se or computer programs representing computer listings per se.

(b) Nonfunctional Descriptive Material

(c) Natural Phenomena such as Electricity or Magnetism

Applicant maintains that the Patent Office has failed to establish a prima facie case as to why the subject matter in the claims is nonstatutory because the Patent Office has failed to so classify the claims into the appropriate category of nonstatutory subject matter. Nevertheless, Applicant respectfully maintains that the claims do not fall into one of these non-statutory subject matter categories. The Office Action recites claims lack of an indication that a computer performs some of the steps. Applicant is unaware of any standard for statutory subject matter that requires that a claim make explicit that a computer must perform the steps and respectfully requests that the Patent Office provide a basis for such a standard being applied.

The First 35 U.S.C. § 103 Rejection

Claims 74, 75, 79, 82, 83, 87, 90, 91, 95, 98, 99 and 103 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Chen et al.[1] in view of Hill et al.[2], among which claims 74, 82, 90 and 98 are independent claims. This rejection is respectfully traversed.

[1] U.S. Patent No. 6,076,107
[2] U.S. Patent No. 6,484,239

According to the Manual of Patent Examining Procedure (M.P.E.P.),

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.[3]

Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in Chen except that Chen does not teach determining if a request contains a defined pattern or determining if data responsive to the data request is contained in a cache of prefetched data if the data request contains a pattern defined in the memory.[4] The Office Action further contends that Hill teaches determining if a request contains a defined pattern and determining if data responsive to the data request is contained in a cache of prefetched data if the data request contains a pattern defined in the memory and that it would be obvious to one having ordinary skill in the art at the time of the invention to incorporate Hill into Chen in order to enable prefetching only when there exists a pattern demonstrating improvements that are to be obtained by prefetching. The Applicants respectfully disagree for the reasons set forth below.

Hill fails to teach or suggest "determining if data responsive to the data request is contained in a cache of prefetched data if the data request contains a pattern defined in the memory"

Contrary to what is stated in the Office Action, Hill fails to teach or suggest "determining if data responsive to the data request is contained in a cache of prefetched data if the data request contains a pattern defined in the memory" as claimed in claim 74. Hill examines multiple read

[3] M.P.E.P § 2143.
[4] Office Action ¶ 9.

requests and determines if the pattern of read requests indicates that the arbiter is requesting data in a certain order. For example, Hill determines if the read requests are sequential, and if so, in which order (forward or backwards). If a pattern matches, Hill issues a prefetch request based on this pattern (i.e., prefetches data the arbiter is likely to ask for next).

However, as depicted in Figure 3, Hill checks for a pattern match (step 1060) **after** it determines if the requested data is in the internal cache (step 1210). However, at no point does Hill determine if the requested data is in the internal cache **if** the pattern matches. How can it, since it checks the internal cache before it even determines if there is a matching pattern. Indeed, the pattern matching described in Hill is only utilized to determine which data to prefetch, but is not utilized at all when actually pulling the prefetched data out of the cache. As such, Hill fails to teach or suggest "determining if data responsive to the data request is contained in a cache of prefetched data if the data request contains a pattern defined in the memory."

Therefore, Applicant respectfully submits that claim 74 is in condition for allowance.

As to independent claims 82, 90, 98, these claims contain elements similar to that as described above with respect to claim 74. As such, Applicant respectfully submits that these claims are also in condition for allowance.

As to dependent claims 75, 79, 83, 87, 91, 95, 99 and 103, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

The Second 35 U.S.C. § 103 Rejection

Claims 76-78, 80, 81, 84-86, 88, 89, 92-94, 96, 97, 100-102, 104 and 105 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Chen et al. in view of Hill et al., and further in view of Case et al.[5]. This rejection is respectfully traversed.

As to dependent claims 76-78, 80, 81, 84-86, 88, 89, 92-94, 96, 97, 100-102, 104 and 105, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

[5] "Request for Comments: 1157 (May 1990)"

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

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Dated: 1/30/06

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